

REMARKS

Applicants respectfully request reconsideration of this application in view of the following remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in substantially the same order in which the corresponding issues were raised in the Office Action.

Status of the Claims

Claims 17-28, 33-36 and 40-45 and pending and have been rejected. Claims 17, 18, 22, 27, and 28 have been amended. Claims 38-39 have been canceled. No claims have been added. No new matter has been added.

Summary of the Office Action

Claims 17, 22, 28, and 33-45 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,848,413 to Wolff (hereinafter "Wolff") in view of U.S. Patent No. 5,692,048 to Gormish (hereinafter "Gormish") in view of U.S. Patent No. 6,584,508 to Epstein (hereinafter "Epstein") in view of U.S. Patent No. 6,742,116 to Matsui (hereinafter "Matsui") in further view of U.S. Patent No. 5,870,552 to Dozier (hereinafter "Dozier").

Claims 18, 23 and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wolff, Gormish, Epstein, Matsui, and Dozier in further view of U.S. Patent No. 6,188,673 to Bauer (hereinafter "Bauer").

Claims 19-21 and 24-26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wolff, Gormish, Epstein, Matsui, and Dozier in further view of U.S. Patent No. 6,317,777 to Skarbo et al. (hereinafter “Skarbo”).

Response to Rejections under 35 U.S.C. § 103(a)

Claims 17, 22, 28, and 33-45 were rejected as being unpatentable over Wolff in view of Gormish, and further in view of Epstein, and further in view of Matsui, and further in view of Dozier. Applicant respectfully requests withdrawal of these rejections because the Office action has failed to establish a prima facie case of obviousness and the combination of cited references still fails to teach or suggest all of the limitations of the claims.

Claim 17 recites:

A computer-implemented method comprising:

receiving multiple electronic documents at a server that have been saved in the absence of an explicit command by a user to save the electronic documents **and in response to another user specified function associated with the electronic documents;**

selecting one or more of the multiple saved electronic documents for publication over a network;

transforming the one or more of the selected electronic documents to meet predetermined format- and content-based standards for publication if the one or more selected electronic documents do not meet the standards for publication;

transmitting to one or more recipients authorization information corresponding to the selected electronic documents;

transmitting a document resource identifier, automatically and in association with publication, to one or more independent World Wide Web indexing services; and

the server allowing access to a selected subset of the electronic documents by using the authorization information and the document resource identifier. (Emphasis added).

Applicant respectfully submits that claim 17 is directed to a computer-implemented method having multiple operations. It appears that the Office action, however, has only

provided analysis of the canceled independent claim 1, which is directed to a system having a multifunction machine, a filter, and a server. As a result, the Office action has ignored certain limitations of the claim. For example, no analysis has been provided for the limitation of **“selecting one or more of the multiple saved electronic documents for publication over a network,”** or the limitation of “receiving multiple electronic documents at a server that have been saved ... **and in response to another user specified function associated with the electronic documents”** (emphasis added). As such, the Examiner has not met his burden of demonstrating how each of the claimed limitations is taught or suggested by the combination of cited references.

Moreover, Applicant respectfully submits that the Office action has also failed to establish a prima facie case of obviousness for the reasons provided below.

The Office action asserts that Wolff does not explicitly disclose saving the electronic documents in the absence of an explicit command by a user to save the electronic documents in response to another use specified function associated with the electronic documents. Office action, mailed February 6, 2008, page 3. However, the Office action purports that multifunction machines that perform user specified functions as well as saving documents in the absence of an explicit command are well known as evidenced in Gormish, which discloses a fax machine that automatically saves a certain number of faxes. *Id.*, citing Gormish, col. 1, lines 46-49. In support of this assertion, the Office action states that it would have been obvious to modify the system of Wolff to automatically save a certain number of faxes so that documents could be stored and filed without user intervention thereby reducing time, costs, and error while providing for

future search and retrieval of the documents. *Id.* at pages 3-4. Applicant respectfully disagrees.

Gormish is directed to performing a secure facsimile transmission. Gormish, in a discussion of problems with the current practice of faxing documents, indicated that there is a lack of security in current practices, and that this problem is “[e]ven worse, if the receiver has a facsimile machine which automatically saves a certain number of faxes.” As such, these teachings only indicate that there are facsimile machines that *automatically save a certain number of faxes that it receives*, not that the facsimile machines automatically save multiple electronic documents that are sent to the receiving server. Nothing in Gormish teaches or suggests that the sending facsimile machines automatically save a certain number of faxes that it transmits. Even if, for the sake of argument, the receiving fax is being interpreted to be the receiving server, the Office action has failed to provide some articulated reasoning with some rational underpinning to support the assertion that the server of Wolff be modified to operate like the receiving facsimile machine which automatically save a certain number of faxes it receives. Therefore, the Office action has failed to establish a prima facie case of obviousness because one of ordinary skill would not be motivated, or have reason, to combine the teachings of Wolff and Gormish to arrive at the claimed invention.

Even if, for the sake of argument, one of ordinary skill in the art would have been motivated to combine the cited references, the combination of cited references still fails to disclose this limitation of the claim because Gormish only teaches automatically saving received faxes at the receiving facsimile machine, not that the facsimile machines automatically save multiple electronic documents that are sent to the receiving server. As

such, the cited combination of references still fails to disclose “receiving multiple electronic documents at a server that have been saved in the absence of an explicit command by a user to save the electronic documents.” Moreover, as addressed above, the Office action is silent with respect to the remaining portion of the limitation, namely, that the se4ver receives the multiple electronic documents in response to another user specified function associated with the electronic documents.” Examples of another user specified functions may include copying, printing, faxing, e-mailing, scanning, or the like. See, for example, Applicant’s Specification, page 8, lines 10-18. Accordingly, the combination of cited references still fails to disclose at least this limitation of the claim.

In addition, the Office action indicates that Wolff does not explicitly disclose “a content-based filter to transform on or more of the electronic documents to meet predetermined format and content based standards for publication over a network if one or more electronic documents do not meet the standards for publication.” Office action, mailed February 6, 2008, page 4. The Office action, however, purports that Epstein discloses “a content-based filter that performs any necessary content-based decision-making and modifies the files by performing sanitation (e.g., excising profanity or ‘fixing’ data values) as well as converting file into standard format). *Id.*, citing Epstein col. 9, lines 7-21, line 56 to col. 10, line 5, and Figures 6A and 6B). Regardless of whether Epstein discloses this limitation or not, the Office action has only made a conclusory statement that it would have been obvious to one of ordinary skill in the art to modify the gateway server of Wolff to include the content based filter of Epstein in order to ensure that documents are reviewed prior to publication so that undesirable information is not published over the network. *Id.* In essence, the Office action has

asserted that it would have been obvious to combine the teachings of Wolff and Epstein so that the system of Wolff can content filter the documents prior to publication, as allegedly taught by Epstein, so that undesired information is not published over the network. Such assertion is conclusory because the Office action asserts that it would have been obvious to combine the teachings of Epstein so that the server of Wolff can perform the teachings of Epstein without providing a sufficient reason or explicit analysis of why the disclosures of the references should be combined. Applicant respectfully submits that there is no suggestion to combine the teachings and suggestions of Wolff and Epstein, as advanced by the Examiner, except from using Applicant's invention as a template through a hindsight reconstruction of the Applicant's claims. Applicant respectfully submits that rejections on obviousness grounds cannot be sustained by mere conclusory statements, instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *KSR Int'l v. Telfex Inc.*, 127 S. Ct. 1727. Accordingly, Applicant respectfully submits that the assertion by the Office action is conclusory, and thus, improper, and that the Office action has failed to establish a prima facie case of obviousness.

In addition, the Office action indicates that Wolff does not explicitly disclose transmitting authorization information to one or more recipients, the authorization information to enable the one or more recipients to access one or more of the subset of electronic documents. Office action, mailed February 6, 2008, page 4-5. The Office action, however, purports that Matsui discloses "a server that creates new passwords (authorized information) and transmits the new passwords to each user terminal to enable access to a restricted area. *Id.*, citing Matsui, col. 18, lines 47-52. Regardless of whether

Matsui discloses this limitation or not, the Office action has only made a conclusory statement that “[i]t would have been obvious to a person having ordinary skill in the art to modify the system of Wolff to include the step of the server permitting access to the electronic documents using a document identifier and the server transmitted authorization information in order to prevent unauthorized access to the electronic documents ... and to [prevent] the electronic documents from being retrieved by tm welcome[sic] users.” *Id.* In essence, the Office action has asserted that it would have been obvious to combine the teachings of Wolff and Epstein so that the system of Wolff uses authorization information, as allegedly taught by Matsui, to prevent unauthorized access. Such assertion is conclusory because the Office action asserts that it would have been obvious to combine the teachings of Matsui so that the server of Wolff can prevent unauthorized access without providing a sufficient reason or explicit analysis of why the disclosures of the references should be combined. Applicant respectfully submits that there is no suggestion to combine the teachings and suggestions of Wolff and Matsui, as advanced by the Examiner, except from using Applicant’s invention as a template through a hindsight reconstruction of the Applicant’s claims. Applicant respectfully submits that rejections on obviousness grounds cannot be sustained by mere conclusory statements, instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *KSR Int’l v. Telfex Inc.*, 127 S. Ct. 1727. Accordingly, Applicant respectfully submits that the assertion by the Office action is conclusory, and thus, improper, and that the Office action has failed to establish a prima facie case of obviousness.

Even if, for the sake of argument, the cited references were combinable, Applicant respectfully submits that the combination of cited references still fails to disclose all the claims limitations. Wolff discloses creating an identifier/locator for the document, and when the gateway server receives a request for the document, the gateway is able to *identify* the documents that are requested and forward those onto the requesting agent. As such, Wolff only discloses identifying the document using the document identifier. Nothing in Wolff teaches or suggests allowing access using to the electronic documents, but only that these documents can be identified and forwarded to the requesting agent by using the document identifier. Matsui fails to cure this deficiency. Matsui, only discloses selectively creating a new password and transmitting the new password to each of the user terminals; however, nothing in Matsui teaches or suggests allowing access to the electronic documents using both the authorization information and the document resource identifier. Matsui, at most, discloses allowing access to an electronic conference room using a password. As such, the combination of cited references fails to disclose at least this limitation of the claim.

In addition, the Office action indicates that Wolff does not explicitly disclose that the server, automatically and in association with publication, causes the document identifier to be transmitted to or more independent WWW indexing services. Office action, mailed February 6, 2008, page 5. The Office action, however, purports that Dozier does disclose this limitation, and purports that “one of ordinary skill in the art would have been motivated to transmit document identifier to independent WWW indexing services in order to facilitate [the] search engine in retrieving specific web documents.” *Id.* at page 6. Regardless of whether Dozier discloses this limitation or not,

the Office action has only made a conclusory statement that it would have been obvious to one of ordinary skill in the art to transmit document identifiers to WWW indexing services to facilitate the search engine in retrieving specific web documents. Such assertion is conclusory because the Office action asserts that it would have been obvious to combine the teachings of Dozier so that the server of Wolff can transmit document identifiers for later retrieval by a search engine without providing some articulated reasoning with some rational underpinning to support such an assertion. Applicant respectfully submits that there is no suggestion to combine the teachings and suggestions of Wolff and Dozier, as advanced by the Examiner, except from using Applicant's invention as a template through a hindsight reconstruction of the Applicant's claims. Applicant respectfully submits that rejections on obviousness grounds cannot be sustained by mere conclusory statements, instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *KSR Int'l v. Telfex Inc.*, 127 S. Ct. 1727. Accordingly, Applicant respectfully submits that the assertion by the Office action is conclusory, and thus, improper, and that the Office action has failed to establish a prima facie case of obviousness.

Moreover, the Office action has asserted in response to previous arguments that Dozier col. 16, lines 33-44, which discloses that the WAN document reference in a database may preferably be located anywhere in the WAN and that the WAN-compatible URL need not be stored locally, implies its indexing service is independent. Applicant respectfully disagrees with the Office action's characterization of the cited reference.

Although Dozier does disclose indexing documents, for example, an administrator might systematically index all documents on a server, while individual users might create their own indexing schemes for documents, this type of indexing, whether independent or not (as alleged by the Office action), does not constitute a WWW indexing service. Examples of an independent WWW indexing service may be Yahoo, AltaVista, Excite, an exiting publicity service, or the like. See, for example, Applicant's Specification, page 7, lines 17-19. Moreover, Dozier at most discloses indexing the WAN document with an index WAN-compatible URL (WAN address pointers) to point to the stored location of the electronic document, which can be local or remote from the database that references the WAN document. Dozier, col. 16, lines 33-44. Nothing in Dozier discloses transmitting the WAN compatible URL to a WWW indexing service. As such, the combination of cited references still fails to disclose at least this limitation of the claim.

Given that the Office action has failed to establish a prima facie case of obviousness and that the combination of cited references still fails to teach or suggest all of the limitations of the claim, Applicant respectfully submits that claim 17 is patentable over the cited references. Accordingly, Applicant requests that the rejection of claim 17 under 35 U.S.C. § 103(a) be withdrawn.

Given that claims 18-21, 33-34, and 40-42 depend from independent claim 17, which is patentable over the cited references, Applicant respectfully submits that dependent claims 18-21, 33-34, and 40-42 are also patentable over the cited references. Accordingly, Applicant requests that the rejection of claims 18-21, 33-34, and 40-42 under 35 U.S.C. § 103(a) be withdrawn.

Applicant respectfully submits that claims 22-27 and 28, 35-36, and 43-45 are patentable over the combination of cited references for similar reasons as described above with respect to claim 17. Accordingly, Applicant requests that the rejection of claims 22-27 and 28, 35-36, and 43-45 under 35 U.S.C. § 103(a) be withdrawn.

CONCLUSION

It is respectfully submitted that in view of the amendments and remarks set forth herein, the rejections and objections have been overcome. If the Examiner believes a telephone interview would expedite the prosecution of this application, the Examiner is invited to contact Michael Mallie at 408-720-8300.

Respectfully submitted,

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